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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,054	10/15/2001	Nordine Cheikh	16517.256/38-21(15094)C	3580

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ARNOLD & PORTER LLP
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555 TWELFTH STREET, N.W.
WASHINGTON, DC 20004-1206

EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1647

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/976,054	CHEIKH ET AL.	
	Examiner	Art Unit	
	Marianne P. Allen	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-17 is/are allowed.
- 6) ☒ Claim(s) 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 18, and 19 have been cancelled.

Applicant's arguments with respect to claims 20-25 have been considered. New grounds of rejection follow.

Election/Restrictions

Claims 12-17 are allowable. Claims 20-25, previously withdrawn from consideration as a result of a restriction requirement, contain all the limitations of an allowable claim. Pursuant to the procedures set forth in MPEP § 821.04(a), **the restriction requirement between the inventions, as set forth in the Office action mailed on 9/27/06, is hereby withdrawn** and claims 20-25 are hereby rejoined and fully examined for patentability under 37 CFR 1.104. In view of the withdrawal of the restriction requirement, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Applicant is advised that should applicant amend claims 20-25 in such a manner that they no longer contain all of the limitations required by claims 12-17, the restriction will be reimposed.

Claim Rejections - 35 USC § 112

Claims 20-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claims 20-25 were newly introduced in the amendment filed 7/21/06. Basis was stated to be in the originally filed claims and at page 36, lines 8-9; page 40, lines 12-14, and page 44, lines 8-15.

Original claims 6-7 were directed to a transformed plant containing a nucleic acid in association with regulatory sequences. Original claim 11 was directed to a method of producing a plant overexpressing a protein. Again, the plant contained a nucleic acid in association with regulatory sequences.

Page 36, lines 8-9; page 40, lines 12-14, and page 44, lines 8-15, of the specification do not have any disclosure pertaining to transformed plants, host cells, or organisms.

None of claims 20-25 require that the nucleic acid be in association with regulatory sequences and transformed plants having nucleic acid sequences in the absence of such regulatory sequences are not disclosed.

No basis is seen for any of claims 20-25. In particular it is noted that claims 21-22 are directed to a transformed host cell that is not required to be isolated. As such, these claims also embrace transgenic organisms. Claim 23 encompasses any transgenic organism and not only

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plants. Claim 25 is directed to a transformed plant consisting of a single type of transformed host cell. A plant of this type is not disclosed nor contemplated.

Applicant is requested to point out by page and line number where every limitation of claims 20-25 can be found.

Should applicant overcome this new matter rejection, the claims would be subject to at least the following enablement rejection.

Claims 20-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This is an enablement rejection.

The nucleic acid of claim 12 encodes a partial but not full length sequence encoding a maize adenine phosphoribosyl transferase. (See prior Office actions for a complete discussion of SEQ ID NO: 5.) For those claims that merely require the presence of the nucleic acid in the host cell or plant but not in a context or form where any protein is expressed, the specification does not tell how to use such transformed host cells or plants. For those claims that encompass the nucleic acid in the host cell or plant in a context or form where a protein may be expressed, the nucleic acid of claim 12 does not encode a complete or biologically active protein. The specification does not tell how to use such a transformed host cells or plants.

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It is noted that the specification does not provide any example of a transformed host cell or plant having the sequence of SEQ ID NO: 5.

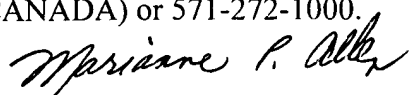
No guidance is provided on producing a transgenic organism such as a cow, bird, or insect. These embodiments are embraced by claim 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Friday, 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Marianne P. Allen
Primary Examiner
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3/2/07

mpa